

R E M A R K S

This is in response to the Office Action that was mailed on January 18, 2005. The non-elected subject matter is cancelled from the claims, without prejudice to its reassertion in this or a continuing application. Specifically, in this regard, claim 2 is cancelled and the reference to claim 2 in claims 4 and 5 is deleted. Claim 1 is amended to replace the recitation of "absorptivity coefficient of light of not more than 7.0 mm<sup>-1</sup>" with the recitation of "transmittance of not less than 93% in the wavelength of 650 nm". This amendment of claim 1 is supported by the description in lines 2-8 on page 15 of the specification. It should be noted that the value "84%" does not appear in the language added to claim 1 -- the Examiner has observed, for instance in the 16<sup>th</sup>-18<sup>th</sup> lines on page 4 of the Office Action, that "the 84% transmittance data for sample 'E' is not relevant to the claimed process". Also, the recitation of original claim 9 is incorporated into claim 1. Finally, claim 11 is recast in independent form. No new matter is introduced by this Amendment. Entry of this Amendment - in order to place the application into condition for allowance or into better conditions for appeal - is respectfully solicited. With this Amendment, claims 1, 3-6, 8, and 10-13 are pending in the application.

Claims 1, 4-6, and 8-13 were rejected under the first paragraph of 35 U.S.C. §112 as failing to comply with the written description requirement. The Examiner alleges that the terminology "absorptivity coefficient of light of not more than  $7.0 \text{ mm}^{-1}$ " does not find adequate basis in the specification as filed. While Applicants do not agree with the Examiner's contentions in this regard, the language in question is removed from the claims in order to expedite the prosecution of the present application. It is respectfully submitted that the claims herein satisfy the requirements of the statute.

Claims 1, 4, 5, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by US 4,748,228 (Shoji). Claims 1, 4, 5, 8, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by US 4,954,144 (Burgoyne). Claims 1, 3-6, 8, 10, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,694,513 (Okaniwa) in view of US 5,108,201 (Matsuura) and US 4,686,147 (Matsuyama). Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Okaniwa in view of Matsuura and Matsuyama and US 5,837,804 (Yamagishi) and US 4,656,235 (Tesoro). Claims 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Okaniwa in view of Matsuura and Matsuyama and Yamagishi and US 5,310,862 (Nomura). Inasmuch as the broadest claim currently pending incorporates the recitation of former claim

9 - which was not the subject of any of the above rejections - none of the above grounds of rejection need be considered further.

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Okaniwa in view of Matsuura and Matsuyama and Yamagishi and US 5,054,872 (Fan). The rejection is respectfully traversed. The sheer number of different references combined by the Examiner to reject the claims herein raises the question of whether the rejection as stated involves improper hindsight.

The rigorous burden placed upon an Examiner for establishing a *prima facie* case of obviousness was reviewed by the United States Court of Appeals for the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, (Fed. Cir. 2002). In *Lee*, the court observes:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

... *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references

can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

It is respectfully urged that the Examiner has not met his burden of proof with respect to the rejection of claim 9.

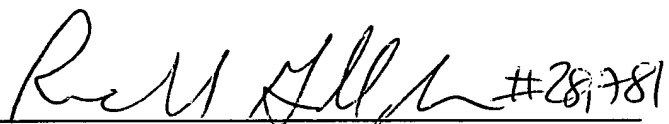
#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #28,781  
Raymond C. Stewart, #21,066

RCS/RG  
0397-0465P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000